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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,445	10/21/2003	Burney J. Latiolais JR.	Frank's Int.-101	3726
21897	7590	06/19/2007		
THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057			EXAMINER CHIN, PAUL T	
			ART UNIT	PAPER NUMBER
			3652	
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			06/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,445

Applicant(s)

LATIOLAIS ET AL.

Examiner

PAUL T. CHIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007 and 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's arguments filed March 12, 2007, have been fully considered but they are not persuasive. **THIS ACTION IS MADE FINAL.**

Drawings

2. The drawings were received on January 12, 2007. These drawings are approved.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3,8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins, III (5,706,894) (see IDS) in view of Williams et al. (2,628,134) (see PTO-892).

Hawkins, III (5,706,894) discloses a ring device comprising a cylindrical ring (1) sized to slide over the exterior surface of the tubular, said ring having a first end, a second end, and a shoulder ring having upper and lower surfaces at its first end and a sidewall between said second end and said shoulder end, said sidewall having a circumferential groove (10) about its interior surface, and a second groove (13,13) through said sidewall for accessing said circumferential groove; a split-ring rigid band (2) having first and second ends (see Fig. 2) positioned within said circumferential groove. Hawkins, III (5,706,894) does not show a latch mechanism on the band being connected between said first and second ends of said band, and said latch mechanism having a handle (123) accessible through said second groove which, when activated, reduces the

internal diameter of said band. However, Williams et al. (2,628,134) teaches a latch mechanism having a handle (6) to firmly lock the band. Accordingly, it would have been obvious to those skilled in the art to provide a latch mechanism on the band of Hawkins, III (5,706,894) as taught by Williams et al. (2,628,134) to firmly lock the band. With regard to material selection, the split ring band (2) is being made of a rigid material. Hawkins, III (5,706,894) does not show that the band is being made of metal. However, it would have been obvious to those skilled in the art to make the band with a metal or stainless steel on the Hawkins's band (2) to provide reliable strength and prevent corrosion to the device. Note that the modified Hawkins, III (5,706,894) is capable of performing the functional limitations.

5. Claims 4-7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins, III (5,706,894) and Williams et al. (2,628,134), as applied to claims 1 and 8, and further in view of Stevenson (2,175,414) (see PTO-892).

The modified Hawkins, III (5,706,894), as presented above, does not show a second split ring to bond to the exterior of the sidewall of the first cylinder ring. However, Stevenson (2,175,414) teaches a split ring (36,37) (see Fig. 4) to wrap to the exterior of the sidewall of a first cylinder ring (35). Accordingly, it would have been obvious to those skilled in the art to provide a second split ring over the band of Hawkins, III (5,706,894) as taught by Stevenson (2,175,414) to further protect the shoulder ring of Hawkins. Note that Stevenson (2,175,414) shows a split ring having a cu-out portion (see Fig. 5) which can be aligned with the second groove and figure 1 shows a beveled edge. It also would have been obvious to those skilled in the art to make the ring with a non-metal

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material such as a plastic on the second ring of Stevenson (2,175,414) to prevent corrosion to the device.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1,3-8, and 10-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/689,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application claims are encompassed by the subject matter in the claims of the copending application. Both of the instant application and the copending application recite a cylinder ring having a shoulder ring, a sidewall having a circumferential groove, a split metal band having a latch mechanism, the metal band having a saw tooth inner diameter, and a second band to grip the external surface of the tube.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

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8. Applicant's arguments filed March 12, 2007, have been fully considered but they are not persuasive.

In response to applicant's argument that William's device ('134) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Williams's device teaches a protective collar for drill pipes and the primary reference, Hawkins, III (5,706,894) teaches a ring device sized to slide over the exterior surface of a tubular.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Hawkins a ring device by providing a latch mechanism from Williams's device to firmly lock the split band.

In response to applicant's argument that "Hawkins's patent is intended as a means to suspend various down-hole tools" a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Note that the recited claims are apparatus claims and do not recite method claims.

Therefore, it meets the claim.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PTC



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